

## REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are requested.

Claims 1-17 remain pending.

### **I. Miscellaneous Matters**

Upon reviewing the application, an error was noted in Figure 3b. Specifically, in box 260, the term "browser" should have been "server". Replacement drawing sheets, including a corrected version of Figure 3b are submitted herewith.

The specification has been reviewed and, where appropriate, amended to address the objections raised in paragraph 1 of the Office Action.

Claim 13 is amended to address the objection thereto raise in paragraph 2 of the Office Action.

In paragraph 4 of the Office Action, the Examiner has rejected the claims, and claim 1 in particular, under 35 USC 112(1) as failing to comply with the enablement and best mode requirements. The rejection is respectfully traversed.

Claim 1 recites the step of "comparing the user's first response to the user's subsequent response(s)," and the Examiner contends that the specification fails to teach one of ordinary skill in the art the best mode (whether by hand, computer, or like device) for performing the comparison. Such teaching, however, is unnecessary because persons of ordinary skill in the art would be readily aware of many means by which survey participant responses could be compared. Also, a person of ordinary skill in the art would recognize that effective means of comparison can vary depending, among other things, on the nature and volume of the data to be compared.

Accordingly, the specification and claims comply with the enablement and best mode requirements, and the rejection of claims 1-17 under section 112(1) should be withdrawn.

Claim 9 is rejected under 35 USC 112(2). Claim 9 has been amended to clarify that, in the context of claim 9, a producer provides the item to the online vendor free of charge.

## **II. Statutory Subject Matter Rejection**

Claims 1-17 stand rejected as purportedly being addressed to non-statutory subject matter. Specifically, the Examiner contends:

In the present case, claims 1-17 only recite an abstract idea. The recited steps of merely obtaining, storing, sharing and analyzing information from online users regarding items does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Office Action at p. 4, ¶ 7.

Applicants traverse the rejection on the grounds that the claimed invention is not an abstract idea and, moreover, on the grounds that to be statutory, it is not required that the invention be linked to a computer or other machine or implement.

### **A. The Claimed Invention Does Not Embody An Abstract Idea**

Statutory subject matter consists of “any new and useful process, machine, manufacturer or composition of matter, or any new and useful improvement thereof ... .” 35 U.S.C. § 101 (emphasis added). “The use of the expansive term ‘any’ in § 101 represents Congress’s intent not to place any restrictions on the subject matter on which a patent may be obtained beyond those specifically recited in § 101 and the other parts of Title 35.” In re Alappat, 33 F.3d 1526, 1542, 31 USPQ2d 1545 (Fed. Cir. 1994). Indeed, the Supreme Court noted that Congress intended statutory subject matter to include “anything under the sun that is made by man.” Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980) (citations and internal quotations omitted). Moreover, the Supreme Court has “cautioned that ‘courts should not read into the patent laws limitations and conditions which the legislature has not expressed.’” Id. at 308 (quoting United States v. Dubilier Condenser Corp., 289 U.S. 178, 199 (1933)).

“[A]bstract ideas constitute disembodied concepts and truths which are not ‘useful’ from a practical standpoint standing alone, i.e., they are not ‘useful’ until reduced to some practical application.” Alappat, 33 F.3d at 1543, n.18 (citations and internal quotations omitted). The Federal Circuit has explained that an invention is not an “abstract idea” if it produces a “useful,

concrete, and tangible result.” Alappat, 33 F.3d at 1544. The invention claimed in this application produces such a result. The presently claimed invention is not an “abstract idea.” That is, the claimed invention does not constitute disembodied concepts and truths which are not useful standing alone.

The result of the present invention includes consumer product sustainability data collected in the context of online sales and marketing of such products. Such data is useful, concrete, and tangible. In other cases, the Federal Circuit has determined that the following are all useful, concrete, and tangible results: (1) “a final share price momentarily fixed for recording and reporting purposes,” see State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998), (2) the condition of a patient’s heart, see Arrhythmia Research Tech. Inc. v. Corazonix Corp., 958 F.2d 1053, 1058 (Fed. Cir. 1992), and (3) information about a telephone call recipient’s primary interexchange carrier that facilitates differential billing of long-distance calls made by the interexchange carrier’s subscriber, see AT&T Corp. v. Excel Communications, Inc., 172 F.2d 1352, 1358 (Fed. Cir. 1999). Accordingly, the invention in each case which generated these results was deemed to be statutory subject-matter. The consumer product sustainability data collected in accordance with the present invention is every bit as “useful, concrete, and tangible” as the final share price of State Street, the condition of a patient’s heart of Arrhythmia Research, or the information about a telephone call recipient’s primary interexchange carrier of AT&T.

Thus, the claimed invention produces a useful, concrete, and tangible result; it is not merely an abstract idea.

#### **B. Statutory Subject Matter Need Not Be Tied to a Machine**

The Examiner contends there is a two-pronged test for statutory subject matter, namely, the claimed invention must be within the technological arts and it must produce a useful, concrete, and tangible result. Office Action at p. 4. Moreover, the Examiner takes the position that to be in the “technological arts” an invention must be intimately associated with some sort of technological implement, such as a computer. Office Action at p. 5.

Applicants respectfully submit that the Examiner has misconstrued the meaning of the

technological arts requirement. It is well-settled law that the mere fact that method steps can be performed by a human does not mean that the invention is not within the technological arts. See In re Musgrave, 431 F.2d 882, 893 (CCPA 1970) (rejecting the Board's view that claims "are directed to non-statutory processes merely because some or all the steps therein can also be carried out in or with the aid of the human mind . . ."). As noted by the State Street Court:

the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it non-statutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result."

State Street, 149 F.3d at 1374 (citations omitted).

Moreover, the claimed invention is clearly performed with the aid of a computer. Claim 1 recites, for example, "presenting one or more consumer products to the user over a distributed network" and "presenting a questionnaire to the user over the distributed network . . ." By definition, these steps are performed with a computer system; it more than mere "nominal recitation of technology." Applicant respectfully questions how the step of presenting data "over a distributed network" could be performed "in the mind of the user or by use of a pencil and paper" as the Examiner contends?

Some courts have held that an invention is statutory if it is within the "technological arts," see In re Toma, 575 F.2d 872, 877 (CCPA 1978); Musgrave, 431 F.2d at 893, while other courts have held that an invention is statutory if it produces a "useful, concrete, and tangible result." See State Street Bank, 149 F.3d at 1373; AT&T Corp., 172 F.2d at 1358; Alappat, 33 F.3d at 1544. The "useful, concrete, and tangible result" inquiry and the "technological arts" inquiry are not, however, different and distinct tests; they are simply differently-named frameworks for assessing the same issue, i.e., whether the claimed invention is directed to an abstract idea.

The phrase "technological arts," as used in the judicial decisions addressing that term, is synonymous with the phrase "useful arts" as it appears in Article I, Section 8 of the Constitution. See In re Waldbaum, 457 F.2d 997, 1003 (CCPA 1972) (noting that "[t]he phrase 'technological arts,' . . . is synonymous with the phrase 'useful arts'"). Since the term "arts" is common to both

phrases, the term "technological" is synonymous with the term "useful." In this regard, therefore, the "technological arts" inquiry overlaps the "useful, concrete, and tangible" inquiry; it is simply another way of ascertaining whether the claimed invention is merely an abstract idea.<sup>1</sup>

The Patent Office has regularly issued patents having claims with steps which could be performed manually. For example, in U.S. Patent No. 5,090,734, entitled "Method for effecting evaluation of consumer goods by test panel members," to W. Richard Dyer, the inventor of this application, claim 1 recites:

1. A multi-wave method for effecting evaluation of consumer products by test panel members, comprising:
  - A) selecting a plurality of test panel members to receive a first set of test materials from a test administrator;
  - B) conducting a base wave by providing each test panel member with said first set of test materials, said first set of test materials comprising:
    - 1) a base evaluation set of products,
    - 2) a first video tape containing a video presentation on products in said base evaluation set, and
    - 3) means for ordering at least one of the products in said base evaluation set;
  - C) instructing each panel member to respond to the base wave by utilizing the ordering means to order at least one of said products in said base evaluation set;
  - D) conducting a subsequent wave after conducting base wave (B) by providing each test panel member with a subsequent set of test materials, said subsequent set of test materials comprising:
    - 1) a subsequent evaluation set of products;
    - 2) a subsequent video tape containing a video presentation on each product in said subsequent evaluation set, and
    - 3) means for ordering at least one of said food products in said subsequent evaluation set;
  - E) instructing each panel member to respond to the subsequent

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<sup>1</sup> The Board of Patent Appeals and Interferences acknowledged that the two tests are related when it stated "[t]he phrase 'technological arts' has been created to offer another view of the term 'useful arts.'" Ex Parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Int. 2001) (unpublished).

- wave by utilizing the ordering means to order at least one of said food products in said subsequent evaluation set; and
- F) recording in a data file the identity of products ordered by each test panel member.

This invention has no steps tied to a computer or technology.

If the Patent Office now seeks to shut the Section 101 door on such claims, it is doing precisely what the Supreme Court admonished courts not to do when it said "courts should not read into the patent laws limitations and conditions which the legislature has not expressed." Chakrabarty, 447 U.S. at 308 (citations and internal quotations omitted). The Congress has not expressed limitations and conditions requiring patentable inventions to be tied to implementation with a machine, such as a computer. If the patent laws are to be limited such that the claims of the present application are deemed non-statutory, such a limitation must be effected by Congress, not the Patent Office.

The rejection of claims 1-17 under 35 USC 101 should be withdrawn.

### **III. Prior Art Rejections**

Claims 1, 3-5, 11, and 17 stand rejected under 35 USC 103(a) as being unpatentable over an article by Pitkow et. al. in view of Dyer, US Patent No. 5, 090,734. Claim 1 has been amended to clarify the distinction between the claimed invention and the prior art teachings.

Pitkow et al. article describes using the web as a survey tool. In the article, the authors have described the results of a user survey that was made available to the web user population for a limited period of time. Users were invited to participate in the survey, and if the users accepted the invitation, a survey questionnaire was presented. The survey questionnaire included adaptive questions whereby answers provided to certain questions were used to determine a subsequent series of questions. When a user would answer questions and submit the responses, one of three possible results would occur: (1) the response triggers an adaptive question to be added to the list of questions asked during the next iteration of questions; (2) if a question is left unanswered, that question is re-asked during the next iteration of questioning; or (3) the response is fine and no further action occurs. The survey follows this cycle of question-answer-adapt-re-ask and repeats the cycle until all questions have been answered.

The Examiner contends that, based on the teaching of this article combined with Dyer's earlier patent on sustainability testing, it would have been obvious to a person of ordinary skill in the art to derive the on-line sustainability testing procedure claimed in this application.

Claim 1 originally recited presenting a first item to a user and presenting a question to the user in response to the user's selection of the item. The Examiner contends that Pitkow and Recker's teaching of presenting an invitation to participate in a on-line survey and thereafter presenting a questionnaire if the user elects to accept the invitation corresponds to the claimed steps of presenting an item and presenting a question in response to the user's selection of the item. Claim 1 as amended recites "presenting one or more consumer products to the user" and "presenting a questionnaire to the user...if the user selects at least one of the consumer products presented."

Pitkow et al. does not suggest that the invitation to participate in a questionnaire could be replaced by presentation of one or more consumer products. Any suggestion that Pitkow's teaching could be implemented as a tool for on-line surveys of consumer products sold on-line based on the teaching of Dyer is simply a hindsight reconstruction of the claimed invention.

Accordingly, withdrawal of the rejection based on Pitkow et al. and Dyer is respectfully requested.

All rejections and objections having been addressed, it is respectfully submitted that the present application is now in condition for allowance and a notice to that effect is earnestly requested.

Respectfully submitted,

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